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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/666,816	09/18/2003	Susann Marie Keohane	AUS920030442US1	8940
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IBM CORP. (AUS) C/O MUNSCH HARDT KOPF & HARR, P.C. 3800 LINCOLN PLAZA 500 N. AKARD STREET DALLAS, TX 75201-6659			EXAMINER DAILEY, THOMAS J	
			ART UNIT 2452	PAPER NUMBER
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/666,816	Applicant(s) KEOHANE ET AL.	
	Examiner Thomas J. Dailey	Art Unit 2452	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 November 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1 and 3-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1 and 3-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>11/18/2008; 1/23/2009</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 2 and 11-40 are cancelled as of the amendment filed on November 18, 2003.
2. Claims 1 and 3-10 are pending.

Response to Arguments

3. The applicant's submitted amendment to the specification is accepted.
4. The applicant's claim amendments and arguments have alleviated the specification objection and the 35 U.S.C. 112 rejections of claims 1, 3-6, 11, 13-16, 21, 23-26, 31, and 33-36, and both are hereby withdrawn.
5. Applicant's arguments with respect to claim 1 have been considered but are moot in view of the new ground(s) of rejection.
6. Applicant's arguments with respect to claim 7 have been fully considered but they are not persuasive.
7. The applicant argues with respect to claim 7 that at least for the reason indicated for independent claim 1 (i.e. the cited prior art does not disclose, "enabling the sender, if one of the recipients from the list of recipients has accessed the stored e-mail message...to preclude one of the recipients from the list of recipients that

have not yet accessed the stored e-mail message from accessing the stored e-mail message"), claim 7 is patentable over Brogne (EP Pub. No. 1,087,321) in view of Milewski (US Pat. 5,930,471).

8. The examiner disagrees and notes that the features upon which applicant relies (i.e., "enabling the sender, ***if one of the recipients from the list of recipients has accessed the stored e-mail message***...to preclude one of the recipients from the list of recipients that have not yet accessed the stored e-mail message from accessing the stored e-mail message" (emphasis added)) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

That is Brogne discloses, among other portions of claim 7:

enabling the sender to modify the stored e-mail message (column 3, lines 32-41), including:

determining whether at least one recipient from the list of recipients has already accessed the stored e-mail message (column 5, lines 52-54 and column 6, lines 7-9, the status storage keeps track of how many recipients have accessed the message);

allowing the sender to modify the displayed copy of the stored e-mail message and to send the modified copy to the recipients that have not already accessed the stored e-mail message (*[note the claim language does not take into*

account whether one of the recipients has accessed the stored e-mail message or not] column 6, lines 7-19, sender may modify the e-mail body, and subsequent to this intended recipients will receive the modified e-mail, obviously including recipients that have not already accessed the email).

9. The applicant further argues with respect to the rejection of claim 7 that Brogne clearly teaches away from the modification proposed by the examiner (i.e. the addition of Milewski) and therefore the rejection is improper.
10. The examiner disagrees and notes the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Specifically, to one of ordinary skill in the art the combination of Brogne and Milewski would not have changed the principle operation of Brogne nor rendered the invention unsatisfactory for its intended purpose (see Title, "A method of manipulating an already sent E-Mail and a corresponding server"). Simply, relying on the teaching of Milewski to suggest the generating and sending notification messages to an email sender and intended recipients of a message, and that notification message enabling the send to perform operation on the

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stored message (column 8, lines 53-64 and column 6, lines 25-33) does not run contrary to Brogne's principle function.

11. The applicant further argues with respect to the rejection of claim 7 that Milewski does not appear to enable the sender to access the stored message. The applicant specifically contends Milewski appears to disclose that the sender may only delete the message and even if deleting the message was considered to be accessing the stored message, there would be no message to thereafter send to the recipients that have not already accessed the message. Thus, even if combined, the cited references do not appear to disclose "allowing the sender to modify the displayed copy of the stored message and to send the modified copy to the recipients that have not already accessed the stored e-mail message" as recited in claim 7.

12. The examiner disagrees and notes arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

Specifically, Brogne was relied upon to disclose allowing the sender to modify the displayed copy of the stored e-mail message and to send the modified copy to the recipients that have not already accessed the stored e-mail message

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(column 6, lines 7-19, sender may modify the e-mail body, and subsequent to this intended recipients will receive the modified e-mail, obviously including those that have not already accessed the email).

Claim Rejections - 35 USC § 103

13. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

14. Claims 7-9 are rejected under 35 U.S.C. 103(a) as being unpatentable by Brogne et al (EP Pub. No. 1,087,321), hereafter "Brogne," in view of Milewski et al (US Pat. 5,930,471), hereafter "Milewski."

15. As to claim 7, Brogne discloses a method of modifying a previously transmitted e-mail message by a sender, the message being addressed to a list of recipients (Abstract), the method comprising the steps of:

storing the e-mail message on a computing system (column 2, lines 13-19);
generating a notification message, the notification message for allowing recipients from the list of recipients and the sender access the stored e-mail message (column 2, lines 13-19 and column 3, lines 54-57);

sending the notification message to the recipients from the list of recipients (column 2, lines 15-19); and

enabling the sender to modify the stored e-mail message (column 3, lines 32-41), including:

- determining whether at least one recipient from the list of recipients has already accessed the stored e-mail message (column 5, lines 52-54 and column 6, lines 7-9, the status storage keeps track of how many recipients have accessed the message);

- allowing the sender to modify the displayed copy of the stored e-mail message and to send the modified copy to the recipients that have not already accessed the stored e-mail message (column 6, lines 7-19); and

- replacing the stored e-mail message with the modified copy once the modified copy is sent to the recipients that have not already accessed the stored e-mail message (column 6, lines 7-19).

But, Brogne does not explicitly disclose generating and sending a notification message to the sender and that notification message enabling the modification of a previously sent message. However, Brogne does disclose the sender has access to and can modify the e-mail message as long as all recipients have not retrieved it (Fig. 3); Brogne simply does not explicitly state that a notification message gives the sender the means to do so.

Further, Brogne is silent with regards to displaying the list of recipients and a copy of the stored e-mail message to the user wherein all recipients from the list of recipients that are determined to have already accessed the stored e-mail message are displayed in a distinguishing fashion from recipients that have not already accessed the stored e-mail message.

However, Milewski discloses generating and sending a notification message to the sender and intended recipients of a message and that notification message enabling the sender to perform operations on the stored message (column 8, lines 53-64 and column 6, lines 25-33)) and further displaying the list of recipients and a copy of the stored e-mail message to the sender wherein all recipients from the list of recipients that are determined to have already accessed the stored e-mail message are displayed in a distinguishing fashion from recipients that have not already accessed the stored e-mail message (Fig. 6 and column 8, lines 9-24).

Since both Brogne and Milewski teach methods of accessing previously sent messages by the sender, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute one method of providing the sender with access to the message, including Milewski's notification of what recipients have accessed the message, with the other thereby achieving the predictable result of enabling the sender to modify a previously sent message

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and giving the sender more information with regard to the previously sent message (i.e. what recipients have or have not accessed the message).

16. As to claim 8, Brogne and Milewski disclose the invention substantially with regard to the parent claim, and further disclose discloses the e-mail message having a text portion, the sender being allowed to modify the text portion (Brogne, column 3, lines 39-41).

17. As to claims 9, Brogne and Milewski disclose the invention substantially with regard to the parent claim, and further disclose discloses the e-mail message has a list of recipients, the list of recipients being modified by the sender (Brogne, column 3, lines 32-41).

18. Claims 1 and 3 are rejected under 35 U.S.C. 103(a) as being unpatentable by Brogne et al (EP Pub. No. 1,087,321), hereafter "Brogne," in view of Nielsen (US Pat. 5,870,548) and in further view Milewski et al (US Pat. 5,930,471), hereafter "Milewski,"

19. As to claim 1, Brogne discloses a method of rescinding previously transmitted e-mail messages by a sender, the message being addressed to a list of recipients (Abstract), the method comprising the steps of:

storing an e-mail message on a computing system (column 2, lines 13-19);

generating a notification message, the notification message for allowing recipients from the list of recipients to access the e-mail message (column 2, lines 13-19 and column 3, lines 54-57);

sending the notification message to the recipients from the list of recipients (column 2, lines 15-19);

determining whether one of the recipients from the list of recipients has accessed the stored e-mail message (column 5, lines 52-54 and column 6, lines 7-9, the status storage keeps track of how many recipients have accessed the message as disclosed in column 6, lines 31-37); and

enabling the sender to preclude one of the recipients from the list of recipients that have not yet accessed the stored e-mail message from accessing the stored e-mail message (column 3, lines 32-41).

But, Brogne does not explicitly disclose enabling the sender *if one of the recipients from the list of recipients has accessed the stored e-mail message* to preclude one of the recipients from the list of recipients that have not yet accessed the stored e-mail message from accessing the stored e-mail message. That is it appears that if any one of the recipients has accessed the stored e-mail message in the Brogne teaching (see Fig. 3) a sender may not be able to preclude the other addressees from accessing the message.

However, Nielsen discloses determining whether one of the recipients from a list of recipients has accessed the stored e-mail message (column 14, lines 52-59, it is determined, on per recipient basis, whether an email message has been viewed and column 7, lines 12-19 acknowledges multiple recipients for a given email message); and

enabling the sender if one of the recipients from the list of recipients has accessed the stored e-mail message to preclude one of the recipients from the list of recipients that have not yet accessed the stored e-mail message from accessing the stored e-mail message (column 14, lines 52-64, the original sender can cancel the previously sent email before a recipient views the email; as the process is done on a per recipient basis, even if another recipient has viewed the email it will not effect recipients that have not).

Since both Brogne and Nielsen teach methods of accessing previously sent messages by the sender, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute one method of providing the sender with access to the message with the other thereby achieving the predictable result of enabling the sender to rescind a previously sent message even when it has been viewed by some of the recipients as taught by Nielsen, which allows a sender to correct an error in an email in a broader range of circumstances (i.e. even when it has been viewed by some of the recipients).

Further still, Brogne and Nielsen do not explicitly disclose generating and sending a notification message to the sender and that notification message enabling the preclusion of e-mail access by the receipts. However, Nielsen discloses the sender has access to the e-mail message for even after it is viewed by recipients (column 14, line 65-column 15, line 15); Nielsen simply does not explicitly state that a notification message gives the sender the means to do so.

However, Milewski discloses generating and sending a notification message to the sender and intended recipients of a message and that notification message enabling the sender to perform operations on the stored message (column 8, lines 53-64 and column 6, lines 25-33).

Since Brogne, Nielsen, and Milewski teach methods of accessing previously sent messages by the sender, it would have been obvious to one of ordinary skill in the art at the time of the invention to substitute one method of providing the sender with access to the message with the other thereby achieving the predictable result of enabling the sender to rescind a previously sent message.

20. As to claim 3, Brogne, Nielsen and Milewski disclose the invention substantially with regard to the parent claim, and further disclose discloses the e-mail message having a text portion, the sender being allowed to modify the text portion (Brogne, column 3, lines 39-41).

21. Claim 10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brogne and Milewski as applied to claim 7 above, and further in view of what is well known in the art.

22. As to claim 10, Brogne and Milewski disclose the invention substantially with regard to the parent claim, and further disclose the notification message for automatically accessing the e-mail message being a password (Brogne, column 5, lines 21-24).

Although, Brogne does not explicitly disclose that the password is a public key which decrypts the stored email, Official Notice is taken (MPEP 2144.04) that encrypting emails using a public key password was a well-known use of email access passwords at the time the applicant's invention was made, and is deployed to enhance security of the stored emails. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to take advantage of a well known practice to modify the teachings of Brogne and Milewski in order to achieve such benefits.

23. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Brogne and Nielsen in view of Milewski as applied to claims 1 above, and further in view of what is well known in the art.

24. As to claim 4, Brogne, Nielsen and Milewski disclose the invention substantially with regard to the parent claim, and further disclose the notification message for automatically accessing the e-mail message being a password (Brogne, column 5, lines 21-24).

Although, Brogne does not explicitly disclose that the password is a public key which decrypts the stored email, Official Notice is taken (MPEP 2144.04) that encrypting emails using a public key password was a well-known use of email access passwords at the time the applicant's invention was made, and is deployed to enhance security of the stored emails. Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to take advantage of a well known practice to modify the teachings of Brogne, Nielsen and Milewski in order to achieve such benefits.

25. As to claim 5, Brogne, Nielsen and Milewski disclose the invention substantially with regard to the parent claim 4, and further disclose the computing system is the computing system on which the stored e-mail message was composed (Brogne, column 4, lines 12-26).

26. As to claims 6, Brogne, Nielsen and Milewski disclose the invention substantially with regard to the parent claim 4, and further disclose the computing system is a

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server, the server generating and sending the notification message to the recipients and sender (Brogne, column 2, lines 12-19).

Conclusion

27. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
28. A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.
29. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Thomas J. Dailey whose telephone number is 571-270-1246. The examiner can normally be reached on Monday thru Friday; 9:00am - 5:00pm.

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30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on 571-272-3964. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

31. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. J. D./
Examiner, Art Unit 2452

/Kenny S Lin/

Primary Examiner, Art Unit 2452